

SECTION III—REMARKS

This amendment is submitted in response to the final Office Action mailed December 15, 2004. Claims 1, 5, 19, 23, 24, 27 and 33 are amended herein, and claims 1, 3-5, 7, 8, 19, and 21-38 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the following remarks.

Allowable Claims

The Examiner indicated that claims 27 and 33 would be allowable if amended to overcome the rejections under 35 U.S.C. § 112, second paragraph, set forth in the Office Action. The Examiner also indicated that claims 28-32 and 34-38 would be allowable if re-written to overcome the rejections under 35 U.S.C. § 112, second paragraph, set forth in the Office Action and to include the limitations of the base claim and any intervening claims.

In claims 27 and 33, Applicant has amended the claim to remove the language "uniquely identifies," which the Examiner alleges renders the claims indefinite. The claims now recite a unique Media Access Control (MAC) number associated with a network interface card. Applicant believes that this amendment addresses the Examiner's concerns and overcomes the rejection, and respectfully requests allowance of the claim.

Regarding claims 28-32 and 34-38, none of these claims recited the offending language, and all of these claims now depend from independent claims that are in allowable form. Applicant therefore respectfully requests allowance of these claims.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1, 19, 27 and 33 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In claims 1, 19, 27 and 33 the Examiner alleges that the meaning of "uniquely identifies" is unclear.

Applicant has amended claims 1, 19, 27 and 33 so that they no longer include the phrase "uniquely identifies." Instead, claims 1 and 19 now recite a unique network address associated with a component and claims 27 and 33 now recite a unique Media Access Control (MAC) number associated with a network interface card. Applicant

believes that this amendment addresses the Examiner's concerns and overcomes the rejection, and respectfully requests withdrawal of the rejection and allowance of the claim.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1, 3-5, 19, and 21-24 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 5,704,650 to Laurash *et al.* ("Laurash"), U.S. Patent No. 6,536,660 to Blankenship *et al.* ("Blankenship"), one or both of U.S. Patent Nos. 5,783,810 and 5,793,030 to Kelly, Jr. (collectively "Kelly") and U.S. Patent No. 5,227,617 to Christopher *et al.* ("Christopher"). The Examiner also rejected claims 7, 8, 25 and 26 under § 103(a) as obvious in view of, and therefore unpatentable over, Laurash, Kelly, Blankenship and Christopher further in view of U.S. Patent No. 6,348,685 to Brower *et al.* ("Brower").

Applicant respectfully traverses the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. As explained below, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness.

Claim 1, as amended, recites an article of manufacture comprising a component container and first and second labels removably affixed to the component container, each label having printed thereon "a unique network address associated with a component inside the component container, the unique network address being electronically stored in the component, and the unique network address being read from the component and printed on the labels." The Examiner relies on Blankenship for its disclosure of an identifier electronically stored on a component. Blankenship, however, does not disclose, teach or suggest that the identifier should be a unique network address. Laurash, Kelly, Blankenship and Christopher, whether alone or in combination, therefore cannot disclose, teach or suggest the recited combination, in which each label has printed thereon "a unique network address associated with a component inside the component container, the unique network address being electronically stored in the component, and the unique network address being read from the component and printed on the labels." Applicant

respectfully submits that the combination attempted by the Examiner therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection.

Regarding claims 3-5, 7 and 8, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant respectfully submits that claims 3-5, 7 and 8 are therefore allowable by virtue of their dependence on allowable claim 1, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 19 recites an article of manufacture comprising a base label having a designated area thereon to receive an identification label, and first and second identification labels removably attached to the designated area of the base label, each identification label "having printed thereon a unique network address associated with a component inside a component container to which the base label can be attached, the unique network address being electronically stored in the component, and the unique network address being read from the component and printed on the identification labels." For reasons analogous to those discussed above for claim 1, Applicant submits that Laurash, Blankenship, Kelly and Christopher cannot render the claim obvious, and therefore respectfully requests withdrawal of the rejection.

Regarding claims 20-26, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claims 19 is in condition for allowance. Applicant respectfully submits that claims 20-26 are therefore allowable by virtue of their dependence on allowable claim 19, as well as by virtue of the features recited therein. Applicant therefore respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any

P11384D Amendment F (AF)
BSTZ Seattle

- 9 -

Remarks

informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 2-11-05

Todd M. Becker
Todd M. Becker
Attorney for Applicant(s)
Registration No. 43,487

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606

Enclosures: Transmittal, in duplicate



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,508	12/10/2001	Miguel N. Bermudez	042390P11384D	1145

7590 12/15/2004

Todd M. Becker
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.